

Remarks

A. Summary of Claims

Claim 64 is revised to incorporate the subject matter of claims 68 and 73. Consequently claims 68 and 73 are cancelled. Claim 64 is also revised to define the substrate as an ophthalmic lens. Consequently claim 101 is cancelled. Claim 64 is further revised to state that “the flexible apparatus is flexed to substantially match the curvature of the ophthalmic lens prior to step (d)” and “wherein a pressure force substantially normal to the ophthalmic lens curve surface is applied during moving step (e).” Non-limiting support for these revisions can be found in the specification at page 6, lines 5-7, page 8, lines 12-18, page 17, lines 5-25, and Figures 2-3 and 5-6.

Claims 69-70, 72, 74-75, 78, 91, 94, and 102-103 are revised to correspond to the revisions made in claim 64 and to the cancellation of claims 68, 73, and 101.

Claims 78 and 79 are revised to properly reference the moving and applying steps in claim 64.

Claims 104-120 are cancelled.

Therefore, claims 64-67, 69-72, 74-100, and 102-103 are pending.

B. Anticipation Rejection

As noted above, the subject matter of cancelled claims 68, 73, and 101 are incorporated into independent claim 64. Neither of claims 68, 73, nor 101 were rejected for being anticipated under 35 U.S.C. § 102(b) by U.S. Patent 6,049,428 (“Khan”). As such, Applicant respectfully submits that claim 64 and its dependent claims are not anticipated by Kahn.

Applicant requests that the anticipation rejection be withdrawn.

C. Obviousness Rejection

The Examiner has rejected the subject matter of claims 68 and 73 as being obvious under 35 U.S.C. § 103(a) in view of Kahn. The subject matter of claim 101 was further rejected for being obvious over Kahn in view of U.S. Publication 2004/0145701 ("Miniutti").

Applicant respectfully disagrees with the Examiner for at least the following reasons.

The claimed invention concerns the use of a method for forming a polarizing coating onto a curved surface of an ophthalmic lens. A key aspect of the invention includes using a method that does not deform the curved surface of the ophthalmic lens while applying a polarizing liquid on the surface *via* shear flow. The use of the claimed flexible apparatus and the claimed holder having a curved external surface surrounding the ophthalmic lens surface achieves this. In particular, in order to match the curvature of the ophthalmic lens, the flexible apparatus is flexed before contacting the ophthalmic lens curved surface. The fact of adapting the curvature of the flexible apparatus to the curvature of the ophthalmic lens allows application of a pressure force that is substantially normal to the curved surface, *i.e.* substantially perpendicular to a plane tangent to the curved surface (see specification at page 17, lines 23-25).

By comparison, Kahn simply fails to disclose or suggest such a process. Applicant respectfully submits that the Examiner's position that the rolls of Kahn are inherently flexible and that the rolls match the substrate curved surface is inherent because when a flexible substrate meets an inflexible one, the contact pressure forces a deformation of the flexible surface is not sufficiently supported by Kahn nor by scientific reasoning. The reason for this is that the rolls used in Kahn are made of metal (*e.g.*, steel), and there is no indication in Kahn that such metal rolls have a sufficient amount of flexibility as claimed by Applicant. One cannot presume from a metallic element that its flexibility would be sufficient to match the curvature of an ophthalmic lens.

Further, nothing in Kahn discloses nor suggests flexing its steel rollers prior to applying said rollers to its flat substrate. There would be no reason to do this. As noted above, if Kahn's steel rollers were bent, they would be permanent deformed. Deformed or bent rollers would not work in the manner intended by Kahn, which illustrates coating a flat surface.

Also, under the Examiner's current rationale, "[s]teel deforms under pressure and is therefore capable of being bent, which thereby makes it flexible," (Action at page 2), it would be impossible to achieve a pressure force substantially normal to the ophthalmic lens curve surface. The reason for this is that if Kahn's steel rolls bend, the majority of the pressure will be at the apex of the lens's curved surface and the straight roller. Indeed, it is this interaction, which would ultimately be used to bend Kahn's rollers. Such bending/deformation at this apex would cause a high amount of pressure to be applied across the lens as Khan's roller bends/deforms. Further, one would not expect to have a reasonable degree of success under this scenario, as the pressure at the apex would likely deform or damage the actual lens being coated.

Further, Kahn's metal rolls would not flex back into their original shape. That is, if a sufficient amount of pressure were applied to Kahn's metal rolls, the rolls would permanently bend (*i.e.*, metal deforms plastically and not resiliently). If this were to happen, then the process disclosed in Kahn for coating flat surfaces would be detrimentally affected. That is, the use of a bent roller to apply coating to a flat surface would not be possible, as even distribution of the coating could not happen due to the permanent bend in the roller. Stated another way, if one were to bend Kahn's rollers, the modification would render Kahn's coating process unsatisfactory, which is evidence of non-obviousness. See MPEP § 2143.01(V) ("If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.").

Also, nothing in Kahn discloses or suggests Applicant's claimed holder "such that the curved surface of the ophthalmic lens is freely accessible, wherein said holder comprises a curved external surface surrounding the ophthalmic lens curved surface." Rather, Kahn discloses a flat table. There is simply no reason to modify Kahn's flat table holder, much less to do so in a manner claimed by Applicant. Any such modification would be relying on hindsight analysis given the deficiencies in Kahn's teachings.

With respect to the secondary reference (Miniutti) used by the Examiner to link Kahn's process with a coating process for ophthalmic lenses, Miniutti concerns unfinished lenses or semi-finished lenses including coatings or a transmission altering layer. According to Miniutti, the transmission altering layer can include a polarizer, but this layer is sandwiched between two elements which are laminated to constitute the lens. The transmission altering layers of figures 1A, 28, 38, 44, 48 at 5 are plane. Concerning figure 18, the curved form is introduced by thermoforming the flat unfinished lens of figure 1A (paragraph 28). Therefore, the transmission altering layer of Miniutti is never applied on a curved surface. Given this, the combination of Miniutti and Kahn still fails to disclose Applicant's claimed method for forming a polarizing coating on a curved surface of an ophthalmic lens.

The reality of Kahn's and Miniutti's disclosures is that each, by themselves, or in combination, fail to disclose a method for depositing a polarizing coating on curved surface of a lens. Rather, both references strongly suggest applying such coatings onto flat surfaces by using non-flexible rollers. Consequently a person having ordinary skill in the art would not find in any of these documents an indication which would have encouraged him/her to choose a particular flexible apparatus, notably a flexible apparatus which matches the curvature of the substrate surface.

Applicant requests that the obviousness rejection be withdrawn for at least the above-stated reasons.

D. Conclusion

Applicant believes that this is a complete response to the office action and that this case is in condition for allowance. The Examiner is invited to contact the undersigned Applicant's representative at (512) 536-3020 with any comments or suggestions relating to this case.

Respectfully submitted,



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